

REMARKS

In response to the Office Action dated May 3, 2006, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents to *Feigen*, *Kalajan*, *Shintani*, *Coss*, and *del Val*, whether considered alone or in any combination.

Claims 1-20 are pending in this application.

The United States Patent and Trademark Office (the "Office") objected to FIGS. 1 and 2 for allegedly missing reference numerals. The Office also objected to the Abstract and the Title. Claim 13 was additionally objected to for improper antecedence. Claims 4 and 5 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Claims 1-3, 6, and 18-20 were rejected under 35 U.S.C. § 102 (e) as being anticipated by Published U.S. Patent Application 2002/0138554 to Feigen *et al.* Claims 4 and 5 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Feigen* in view of U.S. Patent 6,202,156 to Kalajan. Claims 7-10 and 13-14 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Published U.S. Patent Application 2002/0095687 to Shintani *et al.* in view of U.S. Patent 6,170,012 to Coss *et al.* Claim 11 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shintani* in view of *Coss* and further in view of U.S. Patent 6,128,653 to del Val *et al.* Claims 12 and 15-17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shintani* in view of *Coss* and further in view of *Feigen*.

As the Assignee shows, however, the Abstract, drawings, and pending claims fully comply with the patent laws and regulations. The pending claims additionally distinguish over the cited documents to *Feigen*, *Kalajan*, *Shintani*, *Coss*, and *del Val*, whether considered alone or in any combination.

Objection to the Drawings

The Office objects to FIGS. 1 and 2 for allegedly missing reference numerals. The Assignee, however, finds that all reference numerals are properly shown and referenced in FIGS. 1 and 2. The Assignee, then, respectfully asserts that the originally-submitted drawings fully comply with § 1.83. If Examiner Hossain still believes an error exists, Examiner Hossain is invited to call Scott Zimmerman at (919) 387-6907.

Objection to the Specification

The Office objected to the Abstract and to the Title. Both the Abstract and the Title have been amended and fully comply with the patent laws and regulations.

Objection to Claim 13

Claim 13 was additionally objected to for improper antecedence. Claim 13 has been amended and fully complies with the patent laws and regulations. Examiner Hossain is thanked for the keen eye.

Rejections under 35 U.S.C. § 112

Claims 4 and 5 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. "To comply with the written description requirement ..., each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure." Department of Commerce, Manual of Patent Examining Procedure § 2163 (II) (3) (b) (Rev. 1, Feb. 2003) (hereinafter "M.P.E.P."). Here Examiner Hossain asserts that the original specification fails to "disclose a device, which is not a set top box, to further comprise a firewall."

The Assignee respectfully disagrees. Paragraph [0023] of the originally-filed application teaches that in "some embodiments, [a] residential gateway 114 is a set top box." The Assignee, then, strongly asserts that claims 4 and 5 completely satisfy the written description requirement.

At least paragraph [0023], then, fully conveys to one of ordinary skill in the art how “a firewall [is] capable of analyzing the resource information” and how “the firewall is disposed logically between the port and other components associated with the device.” The Assignee, then, respectfully submits that claims 4 and 5 fully comply with the written description requirement of § 112, paragraph 1. Examiner Hossain is respectfully requested to remove the § 112 rejection.

Rejection of Claims under 35 U.S.C. § 102 (e)

Claims 1-3, 6, and 18-20 were rejected under 35 U.S.C. § 102 (e) as being anticipated by Published U.S. Patent Application 2002/0138554 to Feigen *et al.* A claim, however, is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

Claims 1-3, 6, and 18-20 are not anticipated. These claims recite, or incorporate, features that are not taught or suggested by *Feigen*. Independent claim 1, for example, recites “a port receiving resource information associated with a set top box describing a number of disk drives and a capacity of each disk drive.” Support for such features may be found at least at paragraphs [0042] and [0043] of the as-filed specification. A “clean” version of independent claim 1 is reproduced below.

1. A set top box, comprising:

a port receiving resource information associated with the set top box describing a number of disk drives and a capacity of each disk drive;

a database in the set top box storing configuration information for the set top box ; and

a processor comparing the resource information to the configuration information and, when the resource information differs from the configuration information, detecting unauthorized modifications to the set top box.

Feigen cannot anticipate such features. The patent to *Feigen et al.* is entirely silent to “a port receiving resource information associated with the set top box describing a number of disk drives and a capacity of each disk drive.” Because *Feigen* does not disclose at least these features, *Feigen* cannot anticipate claims 1-3, 6, and 18-20. The Assignee, then, respectfully requests removal of the § 102 (e) rejection.

Rejection of Claims 4 & 5 under 35 U.S.C. § 103 (a)

Claims 4 and 5 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Feigen* in view of U.S. Patent 6,202,156 to Kalajan. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

1. Because the Proposed Combination of *Feigen* and *Kalajan* Fails to Teach or Suggest All the Claimed Features, the *Prima Facie* Case for Obviousness Must Fail

The proposed combination of *Feigen* and *Kalajan* cannot obviate claims 4 and 5. These claims depend from independent claim 1 and, therefore, incorporate the same distinguishing features. The proposed combination of *Feigen* and *Kalajan*, for example, still fails to teach or suggest “a port receiving resource information associated with the set top box describing a number of disk drives and a capacity of each disk drive.” Because the proposed combination of *Feigen* and *Kalajan* is entirely silent to at least these features, the *prima facie* case must fail. Examiner Hossain is respectfully requested to remove the § 103 (a) rejection.

2. Because No “Teaching, Suggestion, or Motivation” was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness must include "some teaching, suggestion, or motivation" to combine prior art that is found "either in the references themselves or in the knowledge generally available to one of ordinary skill." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). Here, however, the Examiner's *prima facie* case wholly fails to include any teaching, suggestion, or motivation. Examiner Hossain cites no passage from *Feigen* and/or *Kalajan* to support the *prima facie* burden. Examiner Hossain also fails to assert anything found in the knowledge generally available to one of ordinary skill. The *prima facie* case for obviousness, then, is at least improper for failing to provide any teaching, suggestion, or motivation to combine, as M.P.E.P. § 2143 requires. The Assignee thus respectfully asserts that the § 103 (a) rejection of claims 4 and 5 is improper and should be removed.

3. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner's *prima facie* case for obviousness is defective for another reason. The Examiner's *prima facie* case for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* case wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The § 103 (a) rejection of claims 4 and 5 is improper and should be removed.

Rejection of Claims 7-10 & 13-14 under 35 U.S.C. § 103 (a)

Claims 7-10 and 13-14 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Published U.S. Patent Application 2002/0095687 to Shintani *et al.* in view of U.S. Patent 6,170,012 to Coss *et al.* The proposed combination of *Shintani* and *Coss*, however, still fails to teach or suggest all the features recited in independent claims 7 and 13. These independent claims recite "*a resource manager storing the resource information associated with the set top*

box describing a number of disk drives and a capacity of each disk drive, the resource manager comparing the resource information to configuration information and, when the resource information differs from the configuration information, the resource manager detects unauthorized modifications to the set top box.” Because the proposed combination of *Shintani* and *Coss* is silent to at least these features, one of ordinary skill in the art would not think that claims 7-10 and 13-14 are obvious. The *prima facie* case must fail, so Examiner Hossain is respectfully requested to remove the § 103 (a) rejection of claims 7-10 and 13-14.

Moreover, the *prima facie* cases are defective. The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner’s *prima facie* case for obviousness wholly fails to include any teaching, suggestion, or motivation. The Examiner’s *prima facie* case for obviousness also wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The § 103 (a) rejection of claims 7-10 and 13-14 is improper and should be removed.

Rejection of Claim 11 under 35 U.S.C. § 103 (a)

Claim 11 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shintani* in view of *Coss* and further in view of U.S. Patent 6,128,653 to del Val *et al.* Claim 7, however, depends from independent claim 7 and, thus, incorporates the same distinguishing features. The proposed combination of *Shintani*, *Coss*, and *del Val* still fails to teach or suggest “*a resource manager storing the resource information associated with the set top box describing a number of disk drives and a capacity of each disk drive, the resource manager comparing the resource information to configuration information and, when the resource information differs from the configuration information, the resource manager detects unauthorized modifications to the set top box.”* Because the proposed combination of *Shintani*, *Coss*, and *del Val* is silent to at least these features, one of ordinary skill in the art would not think that claim 11 is obvious. The *prima facie* case must fail, so Examiner Hossain is respectfully requested to remove the § 103 (a) rejection of claim 11.

The *prima facie* case is, again, defective. The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness wholly fails to include any teaching, suggestion, or motivation. The Examiner's *prima facie* case for obviousness also wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The § 103 (a) rejection of claim 11 is improper and should be removed.

Rejection of Claims 12 & 15-17 under 35 U.S.C. § 103 (a)

Claims 12 and 15-17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shintani* in view of *Coss* and further in view of *Feigen*. Claim 12, however, depends from independent claim 7 and, thus, incorporates the same distinguishing features. Claims 15-17 depend from independent claim 13. The proposed combination of *Shintani*, *Coss*, and *Feigen* still fails to teach or suggest “a resource manager storing the resource information associated with the set top box describing a number of disk drives and a capacity of each disk drive, the resource manager comparing the resource information to configuration information and, when the resource information differs from the configuration information, the resource manager detects unauthorized modifications to the set top box.” Because the proposed combination of *Shintani*, *Coss*, and *Feigen* is silent to at least these features, one of ordinary skill in the art would not think that claims 12 and 15-17 are obvious. The *prima facie* case must fail, so Examiner Hossain is respectfully requested to remove the § 103 (a) rejection of claims 12 and 15-17.

The *prima facie* case is, again, defective. The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness wholly fails to include any teaching, suggestion, or motivation. The Examiner's *prima facie* case for obviousness also wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The § 103 (a) rejection of claims 12 and 15-17 is improper and should be removed.

U.S. Application No. 10/029,172 Art Unit 2612
Response to May 3, 2006 Office Action

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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